

R E M A R K S

Claims 1-6 are pending and stand ready for further action on the merits.

It is noted with appreciation that the Examiner has entered the June 12, 2003 Amendment into the official record.

Issues Under 35 U.S.C. §103

Claims 1-3 have been rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over JP 51-148383 (JP '383); and Claims 1-4 have been rejected under 35 U.S.C. §103(a) as being unpatentable over JP 4-123233 (JP '233).<sup>1</sup> Applicants respectfully traverse each of the rejections.

Applicants now respond to the Examiner's arguments set forth in the outstanding Advisory Action using the same paragraph numbers used by the Examiner.

Paragraph Numbered As "3"

The Examiner addresses the issue of the thickness of the ring body. In inventive claim 1, the thickness is limited to 10-100

---

<sup>1</sup> It is unclear from the outstanding Advisory Action, whether new claims 5 and 6 are included in these rejections. Applicants will proceed under the assumption that claims 5 and 6 are included in both of these prior art based rejections.

microns, and in inventive claims 5 and 6, the thickness is limited to 10-70 microns.

The Examiner notes that JP '383 teaches a thickness range of the ring body of 0.1-5mm. The Examiner makes the following assertions: a) the range of JP '383 is only a preferred range; b) the thickness "chosen is simply a function of what are the desired end properties of the wound adhesive tape;" and c) this parameter is well within the skill of the artisan.

Applicants respectfully request that the Examiner reconsiders his position. The advantage of the inventive flexible ring body is that the tape can be rewound. Since the thickness of the ring body of JP '383 substantially falls outside of the thickness range of the ring body of inventive claim 1 (and is clearly distinct from the thickness range of claims 5 and 6), the core of JP '383 would not be sufficiently flexible and readily deformable to allow fingers of the hand to be readily inserted inside the ring-like core to facilitate the rewinding of the adhesive tape thereon.

The Examiner asserts that the thickness is a function of the desired end properties of the user. Clearly, there is no teaching or suggestion by JP '383 that the adhesive tape may be rewound on the ring-like body. Accordingly, if the Examiner's assertion is correct that the thickness is a function of the desired end properties of the user, then the skilled artisan would not be

motivated to reduce the thickness of the body to be within the inventive range.

Applicants submit that the mere fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facia* obviousness. The prior art must contain a suggestion to make the modification, and there is clearly no suggestion by JP '383 to modify the thickness of the ring body to be within the inventive range of claim 1 or the range of claims 5-6. The mere fact that a prior art device could have been modified, does not make the modification obvious unless the prior art suggested the desirability of the modification. See e.g., In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) and Ex parte Tanksley, 37 USPQ2d 1382 (BPAI 1994).

Accordingly, the inventive thickness range is a patentable distinction.

In a separate matter, the Examiner asserts that Applicants' remarks made in pages 4 and 5 of the June 12, 2003 Amendment are unsupported opinions.

Applicants now reiterate these remarks herein for the Examiner's convenience.

As noted in JP '383, the core, which is made of a plastic material, is formed in a flat shape by heating and pressing a plastic pipe that was formed in a cylindrical shape. The core made of paper is formed in a flat shape

by winding sheet-like paper around the outer peripheral surface of the core material and the wound adhesive tape is formed into a flat shape by pressing the entire composite after the adhesive tape is wound around the outer peripheral surface of the cylindrical ring-like core (see lines 13-16 of page 3 of the enclosed English translation). Adhesive tape wound in such a manner frequently forms a crease in the center of the flat-shape wound adhesive tape, which creates a undesirable adherence of the wound adhesive tape. Thus, it is readily apparent that JP '383 certainly does not contemplate the present invention.

Applicants now provide additional information to help the Examiner understand that the formation of the crease would naturally result upon pressing of the ring into a substantially flat structure.

When a plastic film wound around the outer peripheral surface of a cylinder form core is transformed into a flat state, tension is not linked to the plastic film, because the plastic film is able to move freely.

On the other hand, in the case of a wound adhesive tape, tension is linked to the adhesive tape when a cylinder form adhesive tape is transformed into a flat state, because an adhesive face and the back face are being fixed and an adhesive tape is not able to move freely. The adhesive tape is pulled at the "a" position described in Fig. 1.

At the "b" position of Fig. 1, an adhesive tape length of the outside circumference side becomes longer than the inside

circumference side. As a result, a crease occurs at the "b" position because an adhesive tape is not able to move freely.

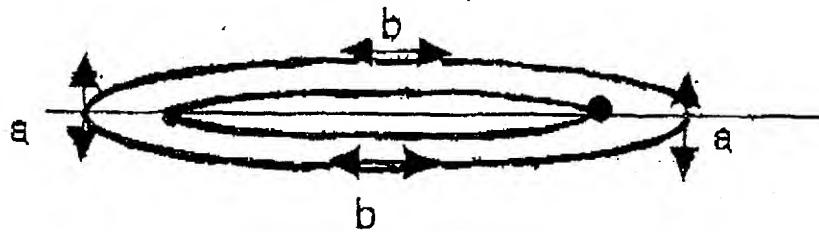


Fig. 1 A flat shaped wound adhesive tape produced by pressing a wound adhesive tape that an adhesive tape is wound around, a cylinder form core.

Accordingly, it is clear that the undesirable crease will result from pressing the ring body of JP '383, and as such, the inventive wound tape is superior to that of JP '383.

In a separate matter, the Examiner asserts that Applicants' remarks made in pages 5 and 6 of the June 12, 2003 Amendment that the presence of printed matter on the inner surface of the ring like body is not obvious based on JP '383 are unsupported opinions and printing on the inner surface is within the skill of the artisan.

Applicants now reiterate these remarks herein for the Examiner's convenience.

The Examiner relies upon JP U62-129043 to show the use of printing on ring bodies. In this connection, it should be noted that the Japanese publication relates to a wound adhesive tape which is wound around a cylindrical formed core which contains printed matter disposed on the circumferential face of the cylindrical core. However, the present invention is concerned with the use of printed matter on a substantially flat ring body which is flexible and readily deformable. Normally, such printed matter could not be provided on such a substantially flat ring body, because it would not be possible to see the printed matter unless the flat ring body is sufficiently flexible and deformable so that it could be sufficiently deformed to read the printed material. Thus, to apply the teachings of JP U62-129043 to the teachings of JP U51-148383, could not arrive at the present invention since JP U51-148383 could not be sufficiently deformed so as to read any printable material provided thereon, and thus one skilled in the art would not be lead to apply the printing concept of the '043 reference to that of the '383 reference. The conclusions reached by the Examiner can only be made in view of the Applicants own disclosure.

Applicants are merely respectfully asking the Examiner to come to a reasonable conclusion which naturally flows from the teachings of JP '383 and JP '043. Applicants have simply taken the position that there would be **no motivation** to place printed matter on the inner face of the flat ring body of JP '383, since the flat ring body of JP '383 is made of a stiff material, and the **user** of the stiff flat ring body would not be able to see the printed matter on the stiff flat ring body because it will not readily bend. There could not be motivation to print subject matter on a place that cannot be seen by the user.

Paragraph Numbered As "4"

The Examiner addresses the issue of the thickness of the ring body. In inventive claim 1, the thickness is limited to 10-100 microns, and in inventive claims 5 and 6, the thickness is limited to 10-70 microns.

The Examiner notes that JP '233 teaches a thickness range of the ring body of 0.5-5mm which is outside the inventive range of 10-100 microns. The Examiner asserts that this parameter is well within the skill of the artisan, and as such, would be obvious.

Applicants respectfully request that the Examiner reconsiders his position. Applicants' arguments regarding the patentability of the present invention over JP '383, as described above, is equally applicable to JP '233. Accordingly, Applicants now summarize the arguments.

The advantage of the inventive flexible ring body is that the tape can be rewound. This advantage would not be seen by the wound tape of JP '233, since the core of JP '383 would not be sufficiently flexible and readily deformable to allow fingers of the hand to be readily inserted inside the ring-like core to facilitate the rewinding of the adhesive tape thereon.

The mere fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient

by itself to establish *prima facia* obviousness. See e.g., In re Gordon and Ex parte Tanksley (both cited above).

Additional Comments

JP '383 and JP '233 relate to a wound adhesive tape comprising a ring-like core formed in a nearly flat shape, and an adhesive tape wound around the circumference face of the ring-like core with an adhesive on the inner surface of the tape. The core is made of a plastic plate or a cardboard paper having a thickness of 0.1mm to 5 mm.

This core of JP '383 and JP '233 needs to have some degree of strength because the adhesive tape is wound around its outer peripheral surface with the adhesive surface usually extending more than 5m in length. Accordingly, the core of JP '383 and JP '233 needs to be manufactured with a stiff material having a thickness of 1 mm or more.

If an adhesive tape having a length of 5m or more were wound to the core having a thickness of 0.5mm produced by using the above mentioned material, the core breaks and also transforms it because winding tension when an adhesive tape is wound around its outer peripheral surface with an adhesive surface inside is so strong.

On the other hand, in a wound adhesive tape in accordance with the present invention, a ring-like core made of a stiff plastic plate having a thickness of 2mm takes charge of winding tension when an adhesive tape is wound, and after the adhesive tape was wound, the above-mentioned ring-like core made of a stiff plastic plate is removed.

Therefore, in the wound adhesive tape in accordance with the present invention, a ring-like body made of a sheet like material having a thickness of 10 $\mu$ m to 100 $\mu$ m does not break and also does not transform it, even though an adhesive tape having a length of at least 5m is wound around the outer peripheral surface of the ring-like body made of a sheet like material having a thickness of 10 $\mu$ m to 100 $\mu$ m with an adhesive surface inside.

JP U62-129043 relates to a wound adhesive tape comprising a cylindrical form core that has something printed on the circumference face of the cylindrical form core and a transparent adhesive tape wound around the circumference face of the cylindrical form core. Users can see the printed matter that was printed on the surface of the cylindrical form core because the adhesive tape is transparent.

Accordingly, in a wound adhesive tape comprising a cylindrical form core and a cloth adhesive tape wound around the

circumference face of the cylindrical form core, the printing is performed to the inside circumference of the cylindrical form core.

However, in a flat shaped wound adhesive tape comprising a ring-like core formed in a nearly flat shape and a cloth adhesive tape, the printing that performed to the inside circumference face of the core was not able to expect any effect at all. Users can't see the printing that is made on the inside circumference face of the core because the central part of the ring-like core formed in a nearly flat shape can't be deformed.

On the other hand, a flat shaped wound adhesive tape in accordance with the present invention comprises an adhesive tape directly wound around the outer peripheral surface of the ring-like body made of a paper that has something printed on the inside circumference face of the ring-like body. Therefore, it is possible to see the printing that has performed to the inside circumference face of the ring-like body because the central part of the ring-like body can be deformed easily.

Based on the foregoing, Applicants respectfully submit that a *prima facie* case of obviousness cannot be said to exist, and as such, withdrawal of the rejections are respectfully requested.

CONCLUSION

In view of the above amendments and comments, Applicants respectfully submit that the claims are in condition for allowance. A notice to such effect is earnestly solicited.

If the Examiner has any questions concerning this application, he is requested to contact Garth M. Dahlen, Ph.D. (#43,575) at the offices of Birch, Stewart, Kolasch & Birch, LLP.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants hereby petition for an extension of three (3) months to September 12, 2003 in which to file a reply to the Office Action. The required fee of \$465.00 is enclosed herewith.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any

overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By Gaston Dell #43575  
for Joseph A. Kolasch, #22,463  
P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

JAK/GMD/gh  
0044-0243P